

REMARKS

Applicant has carefully considered the Final Office Action of October 18, 2005 and offers the following remarks in response thereto.

Applicant appreciates the indication that claims 8-16 are allowable and that claims 17, 24-26, and 31 contain allowable subject matter. However, in light of the deficiencies still present in the rejections, Applicant does not settle for these claims at this time.

Claims 17, 25, and 31 were rejected under 35 U.S.C. § 103 as being unpatentable over Lu et al. (hereinafter "Lu") in view of Cai et al. (hereinafter "Cai"). Claim 24 was rejected under 35 U.S.C. § 103 as being unpatentable over Lu in view of Cai and further in view of Gloeckner. Claim 26 was rejected under 35 U.S.C. § 103 as being unpatentable over Lu in view of Cai and Gloeckner and further in view of Novotny.

These rejections repeat the analysis of the Office Action of May 19, 2005. Applicant has previously addressed these rejections and requests that the analysis provided in the Response filed August 12, 2005 be considered as if set forth in full herein. In particular, in the Response filed August 12, 2005, Applicant argued that the Patent Office had not properly supported the motivation to combine the references. Specifically, Applicant noted that the Federal Circuit requires the Patent Office to do two things before combining references. First, the Patent Office must state a motivation to combine the references, and second, the Patent Office must support the stated motivation with **actual evidence**. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999) (emphasis added). Applicant pointed out that each of the stated motivations in the Office Action lacked the required evidence.

In the Final Office Action of October 18, 2005, the Patent Office responds to Applicant's arguments by citing *In re Fine* and *In re Jones*. While the Patent Office is prone to rely on these two decisions when confronted with an argument based on *Dembiczak*, this reliance is misplaced. The Federal Circuit considered and cited *In re Fine* in the *Dembiczak* decision. In particular, the Federal Circuit noted that while the range of available sources was broad, this breadth did not diminish the requirement for **actual evidence**. *In re Dembiczak* at 999. The Federal Circuit explained that this rigorous requirement was required to insure that the Patent Office did not fall victim to the powerful lure of impermissible hindsight reconstruction.

Despite the admonition to the Patent Office set forth in *Dembiczak*, the Patent Office still fails to provide any evidence to support the stated motivation to combine the references. Instead,

the Patent Office relies on unsubstantiated argumentation. *Dembiczak* indicates that this approach is not proper to sustain a rejection.

Applicant addresses each of the Patent Office's new arguments in turn. First, with respect to the rejection of claims 17, 25, and 31, the Patent Office admits that Lu does not teach dispersion compensation that includes a dispersion discrimination and asserts that "any artisan would know that a dispersion discrimination is needed to provide the information as how much the dispersion compensation is needed." (Office Action of October 18, 2005, page 6, lines 15-17). The Patent Office further states that Cai is cited to show that dispersion discriminations are well known. Regardless of whether this statement is true, the fact that an element is known is not the same as proof that "any artisan would know that a dispersion discrimination is needed. . . ." Thus, the Patent Office has not shown that dispersion discrimination is required in Lu's system.

The Patent Office then states the motivation would be "to measure the dispersion accumulation of the signals propagating through various optical elements and paths and provide variable dispersion compensation to the signals accordingly." (Office Action of October 18, 2005, page 7, lines 3-5). This asserted motivation lacks the required evidence mandated by the Federal Circuit. The Patent Office provides no evidence that measuring the dispersion accumulation of the signals is desirable or needed in this instance. Since the motivation lacks the required evidence, the motivation is not proper. Since the motivation is not proper, the combination is not proper, and the claims are allowable.

The Patent Office concludes its analysis of claims 17, 25, and 31 by stating "Lu further teaches that the compensation block 'may alternatively, or additionally, be placed at inputs to the switch.' (Lu paragraph 0056)." (Office Action of October 18, 2005, page 7, lines 6-7). This citation does not seem to be offered to prove the motivation to combine the references, but rather seems to be responsive to Applicant's arguments that rearranging the elements of the references is improper. While this passage indicates that the compensation block may be repositioned at the inputs, such repositioning is not the modification that the Patent Office is proposing. Rather, the Patent Office is proposing repositioning the dispersion discrimination and the compensation subsystem to the first plurality of optical signals. The repositioning of the compensation block set forth in Lu does not suggest the repositioning of the dispersion discrimination proposed by the Patent Office.

With respect to claim 24, the Patent Office responds to the Applicant's arguments by asserting that it is well known to connect a verification optical link of an optical switch to a processor to verify the switch connections of the optical switch. The Patent Office also notes that Gloeckner was cited to show that this is well known. Without admitting the veracity of this assertion, Applicant notes that merely because an element is known does not mean that it would be obvious to combine it with other elements.

The Patent Office further asserts that the motivation to combine the references is "to provide the information of a possible failure of the switch." (Office Action of October 18, 2005, page 7, lines 21-22). Again, this asserted motivation lacks the required evidence. As noted by the Federal Circuit, the requirement for actual evidence is not diminished by the range of available sources capable of providing motivation to combine the references. Since the Patent Office still has not provided the required evidence, the combination remains improper.

With respect to claim 26, the Patent Office asserts that the use of VOIC to equalize optical powers of plurality of channels is known. Without admitting the veracity of this assertion, Applicant again notes that merely because an element is known does not mean that it would be obvious to combine it with other elements. The Patent Office provides no motivation to further explain the reason for the combination. Since the Patent Office has not provided the required evidence to support the motivation, the combination remains improper.

Since the reasons to combine the references have not been properly supported, the combinations are improper. Since the combinations are improper, the rejections based on the combinations are improper. Since the rejections are improper, the Patent Office has not established obviousness, and claims 17, 24-26, and 31 are allowable.

Applicant requests reconsideration of the rejections in light of the remarks presented herein. The Patent Office is impermissibly combining the references. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

Respectfully submitted,

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